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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,110	09/09/2003	Hans David Hoeg		9223

7590 05/30/2006  
Wesley W. Whitmyer, Jr.  
ST.ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905-5619

EXAMINER

SMITH, PHILIP ROBERT

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No. 10/657,110	Applicant(s) HOEG ET AL.	
Examiner Philip R. Smith	Art Unit 3739	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

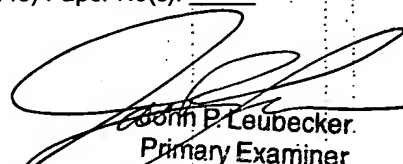
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 9-13.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

  
John P. Leubecker  
Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant contends that "[i]n order for a combination to be proper, there must be some independent suggestion in the art." As noted in the outstanding Office action, Dohi's endoscope allows for "[p]rovision of various endoscope images in good quality without the movement or bending of an endoscope." ([10]). As shown in Figure 11, Chen necessarily gives consideration to the position and orientation of the endoscope when determining the endoscopic line of sight. The position and orientation are adjustable, and their respective adjustment is measurable ("tracking system 97"), in order to provide proper alignment of the endoscopic line of sight with subsurface structures contained in the 3D database. Thus, Chen discloses a procedure comprising acquiring configuration data of a view changing mechanism of the said endoscope, failing only to disclose that said view changing mechanism is "internal." The question then becomes: does the Prior Art disclose an internal view changing mechanism for an endoscope? And furthermore: does the Prior Art provide a motivation for combining such an internal view changing mechanism with the generic endoscope disclosed by Chen? The answers to these questions are 'yes' and 'yes,' as demonstrated in the outstanding Office action. Dohi discloses an internal view changing mechanism. In reduction to practice, a skilled artisan would provide the endoscope disclosed by Chen in the form taught by Dohi in order to provide "various endoscope images in good quality without the movement or bending of an endoscope" ([0008]).

Applicant further contends that both Dohi and Chen teach away from combination with one another. In the case of Dohi, Applicant is unpersuasive, as no evidence is offered. In the case of Chen, Applicant contends that because Chen describes the advantage of considering the scope "as a single unit," he teaches away from combination with an internal view changing mechanism. However, Chen recommends such an assumption only "so long as the optical characteristics of endoscope 90 remain constant," as accurately quoted by Applicant. Certainly, so long as Chen's "position tracking system 97" records no change in the optical characteristics of the endoscope, its line of sight remains constant, and it may be advantageously considered as "behaving like a single unit." This is not to say that Chen "teaches away" from tracking the position of the endoscope. Given that he is silent with regard to the internal versus external nature of the view changing mechanism, which is indubitably disclosed, and furthermore measured by element "97," it is inaccurate to say that he "teaches away" from one or the other configuration.